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GENERAL COUNSEL

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**U.S. District Court
Northern District of Ohio (Cleveland)
CIVIL DOCKET FOR CASE #: 1:08-cv-00284-KMO
Internal Use Only**

Electronics for Imaging, Inc. v. Tesseract, Ltd.
Assigned to: Judge Kathleen M. O'Malley
Case in other court: USDC Northern District of California,
3:07cv05534
Cause: 28:1331 Fed. Question

Date Filed: 02/05/2008
Date Terminated: 03/25/2008
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

Electronics for Imaging, Inc.

represented by **Elizabeth Yang**

Pat. 5,729,665⁸¹ 6,599,325⁸²
5,937,153 6,687,016⁸²
6,209,010⁸¹ 6,771,387⁸²
6,381,028⁸¹
6,487,568⁸¹

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1 software program created by Xerox in the early 1990s. Xerox's VIPP® software and VIPP®-enabling
2 printing systems are compatible with EFI Fiery® print controllers.

3 10. On November 1, 2004, Tesseract sued GMC Software AG and GMC Software
4 Technology, Inc. (collectively "GMC") for patent infringement in the United States District Court for
5 the Northern District of Ohio. Tesseract alleges that all versions of GMC's PrintNet™ software
6 infringe the same seven patents asserted in its suit against Xerox. PrintNet™ is VDP software used to
7 create and produce customized variable data documents.

8 11. In 2005, Tesseract sent a letter to EFI, informing EFI that it had recently filed suit
9 against Xerox and GMC for patent infringement in the United States District Court for the Northern
10 District of Ohio. Tesseract also threatened that EFI should negotiate with it now because, depending
11 on how the litigation against Xerox and GMC progressed, Tesseract may decide that it would be better
12 served enforcing its rights with respect to other parties, including EFI, through litigation.

13 12. EFI has attempted in vain to deal with Tesseract directly. On April 6, 2005, EFI
14 requested for Tesseract to send copies of relevant patents, file histories, and any other documents that
15 would show how Tesseract's patents relate to EFI's products. Tesseract never responded.

16 13. Instead, Tesseract sidestepped EFI and sent letters wrongly alleging patent infringement
17 to many of EFI's customers.

18 14. On or about April 12, 2005, Tesseract sent a letter to Canon explicitly charging that the
19 Canon ColorPASS servers infringe at least several of Tesseract's patents and threatening that if Canon
20 sold its ColorPASS servers without a license, "the cost to Canon could be significant." Canon has
21 demanded that EFI indemnify Canon against Tesseract's claims.

22 15. On September 27, 2006, Tesseract sent a letter to K-M asserting patent rights and
23 explicitly charging that the K-M OEM products infringe at least several of Tesseract's patents.

24 16. EFI sent another letter to Tesseract on January 19, 2007, after Tesseract refused to deal
25 with EFI directly while harassing its customers. EFI reiterated its original request and further asked
26 Tesseract to provide EFI with a claim chart, detailing why Tesseract believed that EFI's products
27 infringe Tesseract's patents. Again, EFI never heard back from Tesseract.

28

17. On March 26, 2007, Tesson sent a claim chart to Ricoh explicitly charging that the Ricoh printing systems infringe at least several of Tesson's patents. On April 27, 2007, Ricoh sent a letter to EFI notifying EFI regarding Tesson's warning of patent infringement.

18. On June 1, 2007, Ricoh sent a letter and claim charts to EFI notifying EFI about further patent infringement allegations from Tesson in regards to the Toshiba printing systems that Ricoh supplied to Toshiba Tec Corp., employing Fiery® controller supplied to Ricoh from EFI.

19. On September 26, 2007, Tesson filed a Complaint in the Northern District of Ohio alleging, inter alia, that K-M's products, which incorporate EFI's Fiery® print controllers, infringe one or more claims of U.S. Patent Nos. 5,729,665 ("the '665 patent"), 5,937,153 ("the '153 patent"), 6,209,010 B1 ("the '010 patent"), 6,381,028 B1 ("the '028 patent"), 6,487,568 B1 ("the '568 patent"), 6,599,325 B2 ("the '325 patent"), 6,687,016 B2 ("the '016 patent"), and 6,771,387 B2 ("the '387 patent"), collectively (the "patents-in-suit"). Tesson based its accusations on the presence of EFI Fiery® print controllers in K-M's products.

20. Shortly after receiving a copy of the Complaint, K-M notified EFI and demanded that EFI defend, indemnify and hold harmless K-M.

21. EFI once again sent Tesson a letter on October 9, 2007 asking Tesson to resolve this conflict with EFI directly.

22. Tesson's continued accusations and threats create an uncertainty concerning EFI's future business plans and an immediate and real controversy now exists between EFI and Tesson on all claims asserted herein. Based on the foregoing, there is an actual, immediate and justiciable controversy between EFI and Tesson as to the infringement and validity of the '665, '153, '010, '028, '568, '325, '016, and '387 patents.

FIRST CLAIM OF RELIEF
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF U.S. PAT. NO. 5,729,665

23. EFI realleges and incorporates the allegations of paragraphs 1 through 22.

24. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily, or otherwise, any valid claim of United States Patent No. 5,729,665 ("the '665 patent").

1 25. To resolve the legal and factual questions raised by Tesserón and to afford relief from
2 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
3 declaratory judgment that it does not infringe the '665 patent.

4
5 **SECOND CLAIM OF RELIEF**
6 **DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 5,729,665**

7 26. EFI realleges and incorporates the allegations of paragraphs 1 through 25.

8 27. One or more of the claims of the '665 patent are invalid for failure to comply with the
9 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
10 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

11 28. To resolve the legal and factual questions raised by Tesserón and to afford relief from
12 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
13 declaratory judgment that one or more of the claims of the '665 patent are invalid.

14 **THIRD CLAIM OF RELIEF**
15 **DECLARATORY JUDGMENT OF UNENFORCEABILITY OF U.S. PAT. NO. 5,729,665**

16 29. EFI realleges and incorporates the allegations of paragraphs 1 through 28.

17 30. The '665 patent is unenforceable.

18 31. To resolve the legal and factual questions raised by Tesserón and to afford relief from
19 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
20 declaratory judgment that the '665 patent is unenforceable.

21 **FOURTH CLAIM OF RELIEF**
22 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF U.S. PAT. NO. 5,937,153**

23 32. EFI realleges and incorporates the allegations of paragraphs 1 through 31.

24 33. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
25 or otherwise, any valid claim of United States Patent No. 5,937,153 ("the '153 patent").

26 34. To resolve the legal and factual questions raised by Tesserón and to afford relief from
27 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
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1 declaratory judgment that it does not infringe the '153 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '153 patent.

3
4 **FIFTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 5,937,153

5 35. EFI realleges and incorporates the allegations of paragraphs 1 through 34.

6 36. One or more of the claims of the '153 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 37. To resolve the legal and factual questions raised by Tesson and to afford relief from
10 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '153 patent are invalid.

12
13 **SIXTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF U.S. PAT. NO. 5,937,153

14 38. EFI realleges and incorporates the allegations of paragraphs 1 through 37.

15 39. The '153 patent is unenforceable.

16 40. To resolve the legal and factual questions raised by Tesson and to afford relief from
17 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
18 declaratory judgment that the '153 patent is unenforceable.

19
20 **SEVENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
21 **U.S. PAT. NO. 6,209,010 B1**

22 41. EFI realleges and incorporates the allegations of paragraphs 1 through 40.

23 42. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
24 or otherwise, any valid claim of United States Patent No. 6,209,010 B1 ("the '010 patent").

25 43. To resolve the legal and factual questions raised by Tesson and to afford relief from
26 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
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1 declaratory judgment that it does not infringe the '010 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '010 patent.

3
4 **EIGHTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 6,209,010 B1

5 44. EFI realleges and incorporates the allegations of paragraphs 1 through 43.

6 45. One or more of the claims of the '010 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 46. To resolve the legal and factual questions raised by Tessonon and to afford relief from
10 the uncertainty and controversy which Tessonon's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '010 patent are invalid.

12
13 **NINTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF
14 **U.S. PAT. NO. 6,209,010 B1**

15 47. EFI realleges and incorporates the allegations of paragraphs 1 through 46.

16 48. The '010 patent is unenforceable.

17 49. To resolve the legal and factual questions raised by Tessonon and to afford relief from
18 the uncertainty and controversy which Tessonon's accusations have precipitated, EFI is entitled to a
19 declaratory judgment that the '010 patent is unenforceable.

20
21 **TENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
22 **U.S. PAT. NO. 6,381,028 B1**

23 50. EFI realleges and incorporates the allegations of paragraphs 1 through 49.

24 51. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
25 or otherwise, any valid claim of United States Patent No. 6,381,028 B1 ("the '028 patent").

26 52. To resolve the legal and factual questions raised by Tessonon and to afford relief from
27 the uncertainty and controversy which Tessonon's accusations have precipitated, EFI is entitled to a
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1 declaratory judgment that it does not infringe the '028 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '028 patent.

3
4 **ELEVENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 6,381,028 B1

5 53. EFI realleges and incorporates the allegations of paragraphs 1 through 52.

6 54. One or more of the claims of the '028 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 55. To resolve the legal and factual questions raised by Tesserón and to afford relief from
10 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '028 patent are invalid.

12
13 **TWELFTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF
14 **U.S. PAT. NO. 6,381,028 B1**

15 56. EFI realleges and incorporates the allegations of paragraphs 1 through 55.

16 57. The '028 patent is unenforceable.

17 58. To resolve the legal and factual questions raised by Tesserón and to afford relief from
18 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
19 declaratory judgment that the '028 patent is unenforceable.

20
21 **THIRTEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
22 **U.S. PAT. NO. 6,487,568 B1**

23 59. EFI realleges and incorporates the allegations of paragraphs 1 through 58.

24 60. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
25 or otherwise, any valid claim of United States Patent No. 6,487,568 B1 ("the '568 patent").

26 61. To resolve the legal and factual questions raised by Tesserón and to afford relief from
27 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
28

1 declaratory judgment that it does not infringe the '568 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '568 patent.

3
4 **FOURTEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 6,487,568 B1

5 62. EFI realleges and incorporates the allegations of paragraphs 1 through 61.

6 63. One or more of the claims of the '568 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 64. To resolve the legal and factual questions raised by Tesserón and to afford relief from
10 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '568 patent are invalid.

12
13 **FIFTEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF
14 **U.S. PAT. NO. 6,487,568 B1**

15 65. EFI realleges and incorporates the allegations of paragraphs 1 through 64.

16 66. The '568 patent is unenforceable.

17 67. To resolve the legal and factual questions raised by Tesserón and to afford relief from
18 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
19 declaratory judgment that the '568 patent is unenforceable.

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21 **SIXTEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
22 **U.S. PAT. NO. 6,599,325 B2**

23 68. EFI realleges and incorporates the allegations of paragraphs 1 through 67.

24 69. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
25 or otherwise, any valid claim of United States Patent No. 6,599,325 B2 ("the '325 patent").

26 70. To resolve the legal and factual questions raised by Tesserón and to afford relief from
27 the uncertainty and controversy which Tesserón's accusations have precipitated, EFI is entitled to a
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1 declaratory judgment that it does not infringe the '325 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '325 patent.

3
4 **SEVENTEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 6,599,325 B2

5 71. EFI realleges and incorporates the allegations of paragraphs 1 through 70.

6 72. One or more of the claims of the '325 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 73. To resolve the legal and factual questions raised by Tesson and to afford relief from
10 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '325 patent are invalid.

12
13 **EIGHTEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF
14 **U.S. PAT. NO. 6,599,325 B2**

15 74. EFI realleges and incorporates the allegations of paragraphs 1 through 73.

16 75. The '325 patent is unenforceable.

17 76. To resolve the legal and factual questions raised by Tesson and to afford relief from
18 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
19 declaratory judgment that the '325 patent is unenforceable.

20
21 **NINETEENTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
22 **U.S. PAT. NO. 6,687,016 B2**

23 77. EFI realleges and incorporates the allegations of paragraphs 1 through 76.

24 78. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
25 or otherwise, any valid claim of United States Patent No. 6,687,016 B2 ("the '016 patent").

26 79. To resolve the legal and factual questions raised by Tesson and to afford relief from
27 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
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1 declaratory judgment that it does not infringe the '016 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '016 patent.

3
4 **TWENTIETH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 6,687,016 B2

5 80. EFI realleges and incorporates the allegations of paragraphs 1 through 79.

6 81. One or more of the claims of the '016 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 82. To resolve the legal and factual questions raised by Tesson and to afford relief from
10 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '016 patent are invalid.

12
13 **TWENTY-FIRST CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF
14 **U.S. PAT. NO. 6,687,016 B2**

15 83. EFI realleges and incorporates the allegations of paragraphs 1 through 82.

16 84. The '016 patent is unenforceable.

17 85. To resolve the legal and factual questions raised by Tesson and to afford relief from
18 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
19 declaratory judgment that the '016 patent is unenforceable.

20
21 **TWENTY-SECOND CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
22 **U.S. PAT. NO. 6,771,387 B2**

23 86. EFI realleges and incorporates the allegations of paragraphs 1 through 85.

24 87. EFI has not infringed, directly, literally, by equivalence, by inducement, contributorily,
25 or otherwise, any valid claim of United States Patent No. 6,771,387 B2 ("the '387 patent").

26 88. To resolve the legal and factual questions raised by Tesson and to afford relief from
27 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
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1 declaratory judgment that it does not infringe the '387 patent and further that K-M's utilization of
2 EFI's Fiery® print controllers does not infringe the '387 patent.

3
4 **TWENTY-THIRD CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF INVALIDITY OF U.S. PAT. NO. 6,771,387 B2

5 89. EFI realleges and incorporates the allegations of paragraphs 1 through 88.

6 90. One or more of the claims of the '387 patent are invalid for failure to comply with the
7 conditions for patentability specified in 35 U.S.C. § 101, et seq., including without limitation the
8 requirements in 35 U.S.C. §§ 101, 102, 103, and/or 112.

9 91. To resolve the legal and factual questions raised by Tesson and to afford relief from
10 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
11 declaratory judgment that one or more of the claims of the '387 patent are invalid.

12
13 **TWENTY-FOURTH CLAIM OF RELIEF**
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF
14 **U.S. PAT. NO. 6,771,387 B2**

15 92. EFI realleges and incorporates the allegations of paragraphs 1 through 91.

16 93. The '387 patent is unenforceable.

17 94. To resolve the legal and factual questions raised by Tesson and to afford relief from
18 the uncertainty and controversy which Tesson's accusations have precipitated, EFI is entitled to a
19 declaratory judgment that the '387 patent is unenforceable.

20 **PRAYER FOR RELIEF**

21 WHEREFORE, Plaintiff EFI prays the Court enter judgment in its favor and against Tesson
22 as follows:

23 A. Determine and declare that the claims of the '665, '153, '010, '028, '568, '325, '016,
24 and/or '387 patents are not infringed by EFI ;

25 B. Determine and declare that the '665, '153, '010, '028, '568, '325, '016, or '387 patents
26 are invalid;

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Defendant

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1 C. Determine and declare that the '665, '153, '010, '028, '568, '325, '016, and/or '387
2 patents are unenforceable;

3 D. A preliminary and permanent injunction barring Tesseract and its officers, agents,
4 servants, employees and attorneys, alter egos and their successors and assigns, as well as those persons
5 in active concert or participation with them who receive actual notice of the judgment, from: (a)
6 charging EFI, its suppliers, vendors, customers, or users of the Fiery® FreeForm, Fiery® FreeForm 2
7 software or Fiery® print controllers with infringement of the '665, '153, '010, '028, '568, '325, '016,
8 or '387 patents; and (b) from threatening to bring or bringing a lawsuit against EFI, its suppliers,
9 vendors, customers, or users of the Fiery® FreeForm, Fiery® FreeForm 2 software or Fiery® print
10 controllers for infringement of the '665, '153, '010, '028, '568, '325, '016, or '387 patents;

11 E. A finding that this is an exceptional case under 35 U.S.C. § 285 and an award of EFI's
12 attorney fees;

13 F. An award of EFI's costs incurred in this action; and,

14 G. Such other and further relief as the Court deems just and proper.
15

16 Dated: October 30, 2007

Respectfully submitted,

17 ELECTRONICS FOR IMAGING, INC.
18 By its Attorneys,

19 By: 

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Attorneys for Plaintiff
ELECTRONICS FOR IMAGING, INC.

DEMAND FOR JURY TRIAL

Plaintiffs hereby demand trial by jury on all issues triable to a jury.

Dated: October 30, 2007

Respectfully submitted,

ELECTRONICS FOR IMAGING, INC.
By its Attorneys,

By: 

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

2008 APR 28 PM 5: 26

U.S. PATENT
AND
TRADEMARK OFFICE

ELECTRONICS FOR IMAGING, INC.,

Plaintiff,

vs.

TESSERON, LTD.,

Defendant.

Case No. 1:08-cv-00284-KMO

Judge Kathleen M. O'Malley

NOTICE OF DISMISSAL

Plaintiff Electronics for Imaging, Inc., pursuant to Federal Rule of Civil
Procedure 41(a)(1)(A)(i), voluntarily dismisses Defendant Tesson, Ltd., from the
above-captioned action without prejudice.

Dated: March 21, 2008

Respectfully submitted,

By: /s/ Jesse D. Mulholland

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Russell B. Hill (*pro hac vice* application
pending)
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Attorneys for Defendant
ELECTRONICS FOR IMAGING, INC.

GRANTED: ✓

DENIED: _____

K. M. O'Malley

U.S. District Judge

3-25-08

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ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
10/30/2007	<u>1</u>	Complaint with jury demand against Tesseron, Ltd. Filed by Electronics for Imaging, Inc. (C,BA) Modified on 2/5/2008 (C,BA). (Entered: 02/05/2008)
11/21/2007	<u>5</u>	Affidavit of Jesse Mulholland of service on Forrest Gautheir, agent for Tesseron Ltd, on 11/14/07 filed by Electronics for Imaging, Inc. (C,BA) Modified on 2/5/2008 (C,BA). (Entered: 02/05/2008)
01/29/2008	<u>29</u>	Order transferring case to USDC, Northern District of Ohio. Signed by Charles R. Breyer, USDC Northern District of California on 1/29/08. (C,BA) Modified on 2/5/2008 (C,BA). (Entered: 02/05/2008)

02/05/2008	● <u>31</u>	Certified copies of docket & Order of Transfer along with original pleadings received from USDC Northern District of California, Case No. 3:07cv5534. (C,BA) Modified on 2/5/2008 (C,BA). (Entered: 02/05/2008)
02/05/2008	●	Random Assignment of Magistrate Judge pursuant to Local Rule 3.1. In the event of a referral, case will be assigned to Magistrate Judge Perelman. (C,BA) (Entered: 02/05/2008)
02/05/2008	●	Notice by Clerk that Electronics for Imaging, Inc. and Tesseron, Ltd. failed to file a corporate disclosure statement as required by Local Rule 3.13(b). (C,BA) (Entered: 02/05/2008)
02/05/2008	● <u>32</u>	Corporate Disclosure Statement by Tesseron, Ltd. filed by Tesseron, Ltd.. (Wallace, David) (Entered: 02/05/2008)
02/11/2008	● <u>33</u>	Order reassigning case to Judge Kathleen M. O'Malley for all further proceedings. Judge Solomon Oliver, Jr no longer assigned to case. Signed by Judges Solomon Oliver, Jr and Kathleen M. O'Malley on 2/11/2008. (D,M) Modified text on 2/12/2008 (B,B). (Entered: 02/11/2008)
02/11/2008	● <u>34</u>	Notice of Hearing. Telephone case management conference to be held on 2/14/2008 at 01:30 PM before Judge Kathleen M. O'Malley. (Court will initiate call. Counsel shall provide telephone number at which they can be reached.) (H,CM) (Entered: 02/11/2008)
02/12/2008	● <u>35</u>	Proposed Stipulation for leave until 2/29/2008 <i>to Plead</i> filed by Defendant Tesseron, Ltd.. Related document(s) <u>1</u> . (Kirsch, Kevin) Modified text on 2/12/2008 (B,B). (Entered: 02/12/2008)
02/12/2008	●	(Court only) Utility Event Terminating Motions. <u>35</u> Stipulated Motion for leave <i>to Plead</i> filed by Tesseron, Ltd.. (B,B) (Entered: 02/12/2008)
02/13/2008	●	Order (non-document) entered 2/13/2008 granting Parties' Stipulation for extension of time until 2/29/2008 for Defendant to respond to complaint <u>35</u> . Judge Kathleen M. O'Malley (H,CM) (Entered: 02/13/2008)
02/14/2008	● <u>36</u>	Case Management Order. Conference held on 2/14/2008. Case assigned to complex track. Parties do not consent to jurisdiction of Magistrate Judge. Case is suitable for ADR and Court directs Mediation conducted by private mediator shall occur by 5/26/2008. Plaintiff's Preliminary Infringement Claims Chart due by 4/17/2008. Defendants' Preliminary Non-Infringement and Invalidity Claims Chart due by 5/12/2008. Plaintiff's Claims Chart due by 6/6/2008, with Defendants' response due by 6/30/2008. Joint Claims Chart due by 7/24/2008. Markman Briefs due by 8/6/2008, with Markman Hearing set on 8/20/2008 at 09:30 AM at Courtroom 16A. Non-Expert Discovery due by 11/6/2008; Expert reports due by 12/5/2008 and 1/6/2009; Expert Discovery due by 2/20/2009; Parties to be Joined and Pleading Amendments due by 7/8/2008; Dispositive Motions due by 3/20/2009. Signed by Judge Kathleen M. O'Malley on 2/14/2008. (Court Reporter

		None.) (H,CM) (Entered: 02/14/2008)
02/26/2008	●	(Court only) Staff Notes: Attorneys Elizabeth Yang, Jesse D. Mulholland, Russell B. Hill, Jon Michaelson & Ben S. Bedi not admitted to practice in this court. Email sent to attorneys re: LR 83.5. (G,CA) (Entered: 02/26/2008)
02/28/2008	● <u>37</u>	Motion for attorney Jesse D. Mulholland to Appear Pro Hac Vice. Filing fee \$ 100, receipt number 06470000000002885701, filed by Plaintiff Electronics for Imaging, Inc.. (Attachments: # <u>1</u> Exhibit A-Affidavit of Jesse D. Mulholland in Support of Motion to Appear Pro Hac Vice) (Moy, Philip) (Entered: 02/28/2008)
02/29/2008	●	Order [non-document] granting Plaintiff's Motion for appearance pro hac vice by Jesse D. Mulholland (Related Doc # <u>37</u>). Judge Kathleen M. O'Malley, entered on 2/29/08.(R,Sh) Modified text on 2/29/2008 (B,B). (Entered: 02/29/2008)
02/29/2008	● <u>38</u>	Proposed Stipulation for leave to <i>Plead until March 7, 2008</i> filed by Defendant Tesson, Ltd.. Related document(s) <u>1</u> . (Kirsch, Kevin) Modified text on 2/29/2008 (B,B). (Entered: 02/29/2008)
02/29/2008	●	(Court only) Utility Event Terminating Motions. <u>38</u> Motion for leave <i>Stipulated Leave to Plead until March 7, 2008</i> filed by Tesson, Ltd.. (B,B) (Entered: 02/29/2008)
03/04/2008	● <u>39</u>	Motion for attorney Russell B. Hill to Appear Pro Hac Vice. Filing fee \$ 100, receipt number 06470000000002891965, filed by Plaintiff Electronics for Imaging, Inc.. (Attachments: # <u>1</u> Exhibit A-Affidavit of Russell B. Hill in Support of Motion to Appear Pro Hac Vice)(Moy, Philip) (Entered: 03/04/2008)
03/05/2008	● <u>40</u>	Attorney Appearance filed by Julie A. Crocker on behalf of Tesson, Ltd.. (Crocker, Julie) Modified text on 3/6/2008 (B,B). (Entered: 03/05/2008)
03/07/2008	● <u>41</u>	Proposed <i>Stipulated Leave to Plead until 3/14/2008</i> filed by Tesson, Ltd.. (Kirsch, Kevin) Modified text on 3/10/2008 (B,B). (Entered: 03/07/2008)
03/21/2008	● <u>42</u>	Notice of Dismissal Under FRCP 41(a)(1) (A) (i) filed by Electronics for Imaging, Inc.. (Mulholland, Jesse) Modified text on 3/24/2008 (B,B). (Entered: 03/21/2008)
03/21/2008	●	Order (non-document) entered 3/21/2008 granting parties' Stipulations <u>38</u> , <u>41</u> extending time until 3/14/2008 for defendant Tesson to respond to complaint. Judge Kathleen M. O'Malley (H,CM) (Entered: 03/21/2008)
03/21/2008	●	Order [non-document] entered 3/21/2008 granting Plaintiff's Motion for attorney Russell B. Hill to appear pro hac vice (Related Doc # <u>39</u>). Judge Kathleen M. O'Malley (H,CM) (Entered: 03/21/2008)
03/25/2008	● <u>43</u>	Order granting Plaintiff's Notice of Dismissal <u>42</u> without prejudice.

		Signed by Judge Kathleen M. O'Malley on 3/25/2008. (H,CM) (Entered: 03/25/2008)
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OFFICE OF THE
GENERAL COUNSEL

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AND
TRADEMARK OFFICE
U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

(14)
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6 ELECTRONICS FOR IMAGING, INC.

7 UNITED STATES DISTRICT COURT
8 NORTHERN DISTRICT OF CALIFORNIA

9
10 ELECTRONICS FOR IMAGING, INC.,
a Delaware corporation,

11 Plaintiff,

12 v.

13 TESSERON, LTD., an Ohio limited liability
14 company,

15 Defendants.

No.

07 5534
COMPLAINT FOR DECLARATORY AND INJUNCTIVE RELIEF

DEMAND FOR JURY TRIAL

1/2 BW

FILED

HOWREY
LLP

1 Plaintiff Electronics for Imaging, Inc. ("EFI"), for its claims against Defendant Tesseract Ltd.
2 ("Tesseract"), alleges as follows:

3 **JURISDICTION**

4 1. This action arises under the patent laws of the United States, Title 35, United States
5 Code. This Court has jurisdiction over the subject matter of this declaratory judgment action under
6 28 U.S.C. §§ 2201, 2202, 1331, 1338(a) and 1367(a).

7 2. This Court has personal jurisdiction over Tesseract by way of Tesseract's ongoing and
8 substantial business in the Northern District of California. Based on information and belief, Tesseract,
9 through its agents, affiliates, and/or alter egos, has continuing and extensive contacts with this forum,
10 including contacts with companies in this forum to which it sells and provides service support for
11 variable data printing ("VDP") software and hardware. Moreover, based on information and belief
12 Tesseract has, through its agents, affiliates and/or alter egos, accused EFI's customers of performing,
13 within this judicial district, acts constituting patent infringement. EFI's principal place of business is
14 within this judicial district.

15 **VENUE**

16 3. Venue is proper under 28 U.S.C. §§ 1391(b), (c) and 1400(b).

17 **INTRADISTRICT ASSIGNMENT**

18 4. EFI's principal place of business is located within the County of San Mateo, and this is
19 an intellectual property action, therefore it can be assigned to the San Francisco Division pursuant to
20 Civil L.R. 3-2(c).

21 **THE PARTIES**

22 5. EFI is a Delaware corporation with its principal place of business within the County of
23 San Mateo at 303 Velocity Way, Foster City, California 94404.

24 6. EFI is informed and believes that Tesseract is an Ohio limited liability company with its
25 principal place of business at 8792 Maineville, Maineville, Ohio 45039.

FACTUAL ALLEGATIONS

1
2 7. In conjunction with its industry-leading Fiery® print controllers, EFI offers pioneering
3 variable data printing ("VDP") solutions. VDP refers to the ability to customize printed material by
4 mixing and matching both graphical and text content. VDP links document layouts to databases
5 including text and graphics objects for combination into personalized documents for printing. During
6 the VDP printing process, computer applications take content from the databases and integrate it into a
7 document according to rules that specify which elements are used and where they are placed. As a
8 result, VDP can make each printed document different by changing the information for each print job.
9 EFI's industry-leading VDP technologies include its Fiery® FreeForm and Fiery® FreeForm 2
10 software, Fiery® print controllers, and mid-range to high-end Fiery® production servers.

11 8. In addition to selling its own products, EFI sells VDP components to other original
12 equipment manufacturers ("OEM's"). OEMs such as Canon USA, Inc. ("Canon"), Ricoh Company,
13 Ltd. ("Ricoh"), and Konica Minolta Business Technologies, Inc. ("K-M"), incorporate EFI's
14 components into their digital printing equipment. Canon utilizes the EFI VDP components in its
15 ColorPASS-Z7500/Z7100/Z6100 servers ("ColorPASS servers"). Ricoh utilizes the EFI VDP
16 components in its Ricoh Aficio Color 3506, Ricoh Aficio Color 4506, Ricoh Aficio Color 6513, Ricoh
17 Aficio Color 3260C, Ricoh Aficio Color 5560, Lanier 5813, Lanier 5625, Lanier LC031, Lanier
18 LC155, Lanier LD160c, Savin SDC326, Savin SDC326A, Savin SDC531, Savin C6045, Savin
19 SDC413, Savin SDC555, Gestetner CS231, Gestetner CS225, Gestetner CS213D, Gestetner CS331,
20 and Gestetner DSc460 variable-enabled printing systems ("Ricoh printing systems") as well as Toshiba
21 e-STUDIO 4500c, e-STUDIO 5500c, e-STUDIO 900, and e-STUDIO 1050 (Ricoh development name
22 Bellini-C2a, Bellini-C2b, Venus-C1a and Venus-C1b, respectively) variable-enabled printing systems
23 ("Toshiba printing systems").

24 9. On October 28, 2004, Tesseract sued Xerox Corporation ("Xerox") for patent
25 infringement in the United States District Court for the Northern District of Ohio. Tesseract alleges
26 that Xerox's VIPP® software and associated VIPP®-enabling printing systems infringe seven patents
27 assigned to Tesseract. VIPP® is an acronym for Variable Data Intelligent PostScript Printware a VDP
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